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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/776,414

02/11/2004

Jonathan Fanger

101896-0239

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EXAMINER

STEWART, ALVIN J

ART UNIT

PAPER NUMBER

3774

NOTIFICATION DATE

DELIVERY MODE

05/29/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@nutter.com

Office Action Summary	Application No. 10/776,414	Applicant(s) FANGER ET AL.	
	Examiner Alvin J. Stewart	Art Unit 3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 21-24, 27-33, 35-40 and 65-76 is/are pending in the application.
- 4a) Of the above claim(s) 5, 11, 27-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10, 12-19, 21-24, 35-40 and 65-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/12/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's request for reconsideration of the rejection of the last Office action is persuasive and, therefore, the last action is withdrawn.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 5-18, 32, 34-36 and 38-40 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17, 25, 27 and 28-32 of copending Application No. 10/664,575. Although the conflicting claims are not identical, they are not patentably distinct from each other because the structure claimed is essentially identical with minor substitutions of terminology such a bore for pathway and the minor preamble difference of intended use as being for a "spinal plate" in the copending

application, the applicant is respectfully reminded that intended use, as set forth in the claims, carries no weight in the absence of any distinguishing structure.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 75 is rejected under 35 U.S.C. 102(b) as being anticipated by Dahl et al US Patent 5,306,278.

Dahl et al discloses a guide device having at least one pair of thru bores comprising an elongated shaft (20) having a proximal end, a distal end, a guide member (12) coupled to the distal end of the shaft and including first and second pathways (26 & 28) at least partially in communication with one another (see Figure below). Additionally, Dahl et al discloses a plurality of alignment elements (40 & 38).

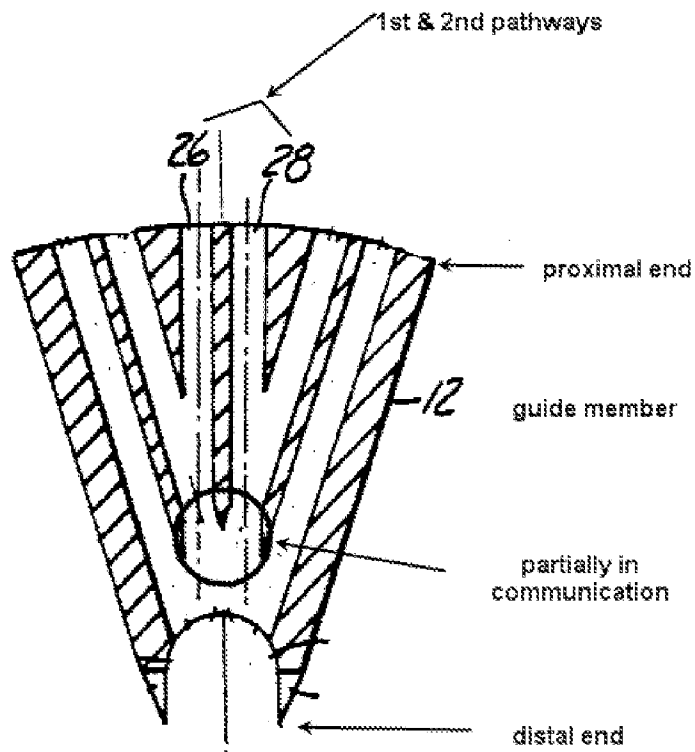
Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

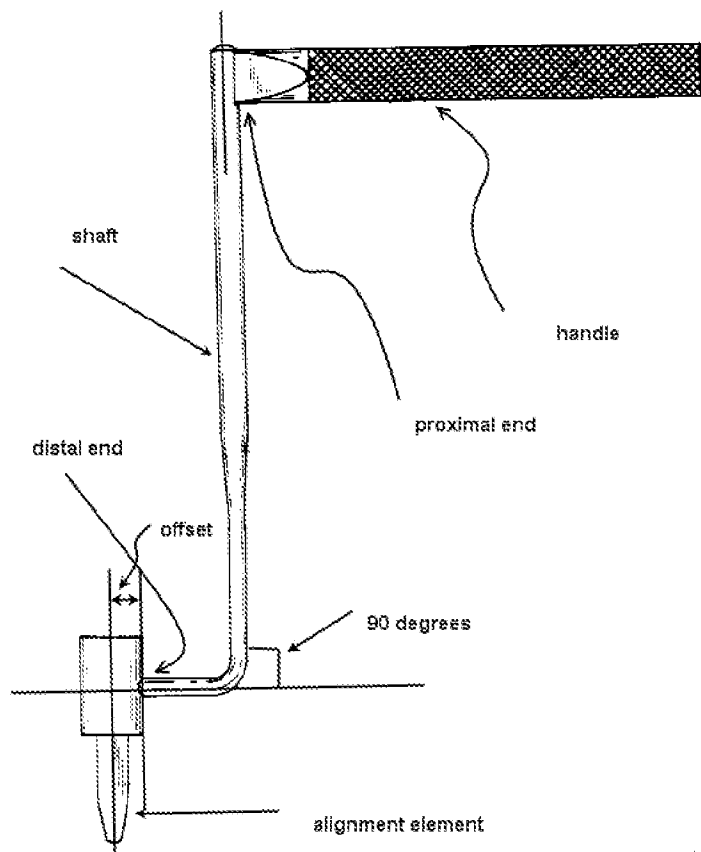
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-10, 12-19, 35-40, and 65-69 rejected under 35 U.S.C. 103(a) as being unpatentable over Dahl et al US Patent 5,306,278 in view of Asfora US Patent Des. 433,506.

Dahl et al discloses a guide device having at least one pair of thru bores comprising an elongated shaft (20) having a proximal end, a distal end, a guide member (12) coupled to the distal end of the shaft and including first and second pathways (26 & 28) at least partially in communication with one another (see Figure below). Additionally, Dahl et al discloses a plurality of alignment elements (40 & 38). However, Dahl et al does not disclose an elongated shaft having a proximal end being positioned at an angle other than 0 degrees with respect to the distal end of the shaft.



Asfora teaches a drill guide having a shaft with a proximal and distal ends. The proximal end being positioned at an angle other than 0 degrees with respect to the distal end of the shaft and the shaft is connected to a guide member and the guide member has a plurality of alignment elements (see figure below).



It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the elongated shaft of the Dahl et al reference with the offset and with the shaft of the Asfora reference in order to facilitate the drilling process during the implantation of a specific device.

Claims 21-24 and 70-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahl et al US Patent 5,306,278 in view of Asfora US Patent Des. 433,506 as applied to the independent claims above, and further in view of Shapiro US Patent 5,324,295.

Dahl et al as modify by Asfora disclose the invention substantially as claimed. However, Dahl et al as modify by Asfora does not disclose a cut-out portion extending between the superior and inferior sidewalls (the Examiner interpreted the superior and inferior sidewalls; and the proximal and distal ends as the top (36) and lower (34) surfaces, shown in Figure 3 of the Dahl et al reference).

Shapiro teaches a guide member with cut-out portions (62 & 64) for the purpose of directing and/or facilitating tools along the length of the guide (see Figure 6).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Dahl et al reference with the Asfora reference in order to direct and/or facilitate the guide of tools along the length of the guide.

Claims 21-24 and 70-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahl et al US Patent 5,306,278 in view of Asfora US Patent Des. 433,506 as applied to the independent claims above, and further in view of Serbousek et al US Patent 6,066,142.

Dahl et al as modify by Asfora disclose the invention substantially as claimed. However, Dahl et al as modify by Asfora does not disclose a C-shaped lateral sidewall for guiding implants, tools and devices.

Serbousek et al teaches a guide member with a C-shaped lateral sidewall for guiding implants, tools and devices (see Fig. 7, elements 224, 226 & 228) for the purpose of directing and/or facilitating tools along the length of the guide.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Dahl et al reference with the Asfora reference in order to direct and/or facilitate the guide of tools along the length of the guide as disclosed by the Serbousek et al reference.

Claims 74 & 76 rejected under 35 U.S.C. 103(a) as being unpatentable over Dahl et al US Patent 5,306,278 in view of Asfora US Patent Des. 433,506.

Dahl et al discloses a guide device having at least one pair of thru bores comprising an elongated shaft (20) having a proximal end, a distal end, a guide member (12) coupled to the distal end of the shaft and including first and second pathways (26 & 28) at least partially in communication with one another. Additionally, Dahl et al discloses a plurality of alignment elements (40 & 38). However, Dahl et al does not disclose an elongated shaft having a proximal end being positioned at an angle other than 0 degrees with respect to the distal end of the shaft.

However, Dahl et al does not disclose a cut-out portion extending between the superior and inferior sidewalls.

Shapiro teaches a guide member with cut-out portions (62 & 64) for the purpose of directing and/or facilitating tools along the length of the guide (see Figure 6).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Dahl et al reference with the Shapiro reference in order to direct and/or facilitate the guide of tools along the length of the guide.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin J. Stewart whose telephone number is 571-272-4760. The examiner can normally be reached on Monday-Friday 7:00AM-5:30PM(1 Friday B-week off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alvin J Stewart/
Primary Examiner, Art Unit 3774

May 27, 2008.